

Application No. 10/821,423
Amendment dated July 9, 2008
Reply to Office action of June 2, 2008

REMARKS:

Status of Claims

Claims 1-45 were previously pending on appeal. Claims 1, 10, 15, 23, and 31 are amended herein. Thus, claims 1-45 remain pending with claims 1, 10, 15, 23, 31, and 37 being independent.

Interview Summary

On November 5, 2007, Applicant and the Examiner exchanged emails as part of an informal written interview. As part of the exchange, Applicant proposed the currently-presented amended claims as being allowable over the prior art of record. No agreement was reached concerning the allowance of any claim.

Office Action

In the June 2, 2008, Office Action, the Examiner reopened prosecution in response to Applicant's Appeal Brief and rejected:

- claims 1 and 15 as being anticipated by Nelson (US 5,890,090);
- claims 1-2, 7-8, 10, 12, 17-22, and 37-45 as being obvious in view of Nelson, Turetzky (US 6,529,829), and Hakala (US 6,452,544);
- claims 3-5 as being obvious in view of Nelson, Turetzky, and Hakala;
- claim 6 as being obvious in view of Nelson, Turetzky, Hakala, and Horvitz (US 6,601,012);
- claims 9, 13-16, 19-22, and 23-40 as being obvious in view of Nelson, Turetzky, Hakala, and DeLorme (US 6,321,158); and
- claim 11 as being obvious in view of Nelson, Turetzky, Hakala, and Smith (US 6,374,179).

Applicant notes that the above rejections are substantially similar to the previously-appealed rejections with the exception that the Examiner has added Nelson to his combination of prior art references. Applicant respectfully submits that the addition of Nelson to the Examiner's previously-appealed combination of references does not provide any evidence that the currently-pending claims are anticipated or obvious as Nelson's teachings are no different than the teachings of previously-cited Turetzky.

Separate and Independently Operable Devices

To facilitate prosecution, independent claims 1, 10, 15, 23, and 31 are amended herein to recite separate and independently operable devices to further clarify that embodiments of the present invention use *two separate devices* to provide triangulation and dead reckoning functionality instead of a single device.¹

The only difference between the current rejections and the previously-appealed rejections is the Examiner's addition of Nelson to each ground of rejection. More specifically, the only difference between the current rejections and the previously-appealed rejections is that the Examiner added a single sentence regarding Nelson's alleged teachings to the present Office Action (pg. 6, ¶ 9).

Nelson, in a similar manner the Examiner's other references, does not disclose using two separate and independently operable devices to perform any functionality and instead clearly teaches only a single device that can use GPS and dead reckoning functionality. As such, Applicant submits

¹ Applicant notes that the unique functionality provided by using two separate devices was discussed at length in Applicant's Second Replacement Brief at pages 14-18. These arguments were apparently persuasive as prosecution was reopened by the Examiner before any decision by the Board.

that Nelson is no more material to the present invention than the Examiner's previously-appealed combination of Turetzky and Hakala. Applicant refers the Examiner to its Second Replacement Brief for a detailed discussion of how the combination of Turetzky, Hakala, Smith, Horvitz, and DeLorme fail to provide any evidence why the claimed invention is obvious.

Independent Claim 37 and Dependent Claims 17 and 44

Claims 17, 37, and 44 each recite that second device provides a cradle for the first device. As discussed in Applicant's Second Replacement Brief, the combination of Turetzky, Hakala, Smith, Horvitz, and DeLorme do not disclose this functionality. In the current Office Action, the Examiner makes no attempt to explain how Nelson—or any other prior art—discloses this feature and instead summarily concludes that the recited cradle functionality would be obvious (Office Action, ¶ 10E). Such summary obviousness conclusions are not a proper ground of rejection.²

Dependent Claim 5

The Examiner contends that Hakala teaches an integrated compass that performs the functionality recited in claim 5. As discussed at length in Applicant's Second Replacement Appeal Brief, a compass does not perform the same functions as the claimed rate gyro sensor. A compass provides an indication of orientation, but only when it is stable and not moving.

Thus, a compass cannot provide any rate of turn information. A rate gyro provides only an indication of rate of turn, and cannot by itself indicate orientation. As a result, a compass and a rate

gyro perform vastly different functions, in vastly different ways, providing vastly different results.

As such, no evidence exists that claim 5 is obvious in view of the Examiner's cited references.

Dependent Claim 12

Claim 12 recites "retrieving navigation related data from a memory of the second mobile device and displaying the navigation related data on an integral display of the first mobile device".

Claim 12 depends from claim 10. Thus, claim 12 not only requires the first and second device to be separable, but also requires that the second, dead reckoning device store navigation data and that the first, triangulation device display the navigation data. Thus, not only are GPS and dead reckoning functions separated, so too are the storage and display of navigation data.

As discussed in Applicant's Second Replacement Brief, the combination of Turetzky, Hakala, Smith, Horvitz, and DeLorme do not disclose this functionality. In the current Office Action, the Examiner makes no attempt to explain how Nelson—or any other prior art—discloses this feature and instead summarily concludes that the invention would be obvious (Office Action, ¶ 10D). As discussed above, such summary obviousness conclusions are not a proper ground of rejection.

Conclusion

In view of the forgoing, Applicant respectfully submits that all claims are now in a condition for allowance. Applicant additionally notes that it has targeted only some of the allowable features

2 An obviousness rejection cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329 (Fed. Cir. 2006).

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in the present Amendment and that a more exhaustive discussion of the claims is presented in the Second Replacement Appeal Brief.

Any additional fee which is due in connection with this Amendment should be applied against our Deposit Account No. 501-791.

Respectfully submitted,

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